REMARKS

Claims 1-20 are pending and at issue in the above-referenced patent application. Of the claims at issue, claims 1, 11 and 16 are independent. Claims 1, 2 and 7 have been rejected as anticipated by Wood et al. (U.S. Patent Application Publication No. US 2002/0054752), claims 3-5, 6, and 8-10 have been rejected as obvious over Wood et al. in view of one or more of Walters et al. (U.S. Patent No. 5,710,970), Gudesen (U.S. Patent No. 5,761,607), and Tsuria et al. (U.S. Patent No. 6,424,947). By way of this amendment, claims 1, 3-8 and 10 have been amended, and claims 11-20 have been added. The foregoing rejections are respectfully traversed and reconsideration is respectfully requested.

Independent claims 1, 11, and 16 specify, *inter alia,* methods to store program data including scheduled program data, program guide data, cache program data, and a boot object having location information associated with the cache program data and requiring storage of the cache program data. No such structure is taught or suggested in the cited references.

Briefly, as set forth in detail below, none of the cited references discloses or suggests the use of a boot object having location information associated with cache program data and requiring storage of the cache program data. Because none of the cited references makes such a disclosure, no combination of these references, even if there were motivation for such a combination, can result in the claimed methods.

It was acknowledged in the Office action dated February 14, 2003 that Wood et al. fails to disclose or suggest a transmission rate of cache program data is different than a retrieval rate of cache program data. In addition, Wood et al. also fails to disclose or suggest the use of a boot object having location information associated with the cache program data and requiring storage of the cache program data. Even though Wood et al. generally suggests storing video data for shows selected for recording based on criteria specified by a viewer, Wood et al. fails to identify, for example, a transponder frequency and service channel

identification (SCID) numbers where data for a cache program is found by transmitting a boot object to a receiver station and to require the receiver station to store the cache program data. In the disclosed system of Wood et al., a broadcaster cannot designate a program to cache and inform the receiver station about the location of data corresponding to the designated cache program. Because selection of shows for recording is based on user specified-criteria, a broadcaster cannot choose to store program data in the receiver station without a subscriber's prior request in the disclosed system of Wood et al. *See* para. [0037]. In contrast, the pending claims 1-20 recite the use of a boot object having location information associated with the cache program data and requiring storage of the cache program data. Accordingly, Wood et al. fails to anticipate pending claims 1-20.

Walters et al. also fails to disclose or suggest the use of a boot object having location information associated with cache program data and requiring storage of the cache program data. In particular, Walters et al. fails to identify where data for a cache program is found by transmitting the boot object to a receiver station, which is required to store the cache program data. Rather, Walters et al. merely discloses a cyclic distribution of audio/video programs that uses a video identification (VID) that uniquely identifies a particular audio/video program. In the disclosed system of Walters et al., a broadcaster cannot choose to record a program into a cache of the receiver station without a prior request by a viewer. For example, the methods recited in the pending claims allow a broadcaster to decide whether to cache a program for viewers in a particular time zone such as the West coast. Instead of using limited bandwidth to rebroadcast the same program on the West coast that was shown three hours earlier on the East coast, the broadcaster may transmit the program data once, and cache the program data for viewers on the West coast. By transmitting the cache program data at a slower transmission rate, the broadcaster reduces disruption of normal transmission of program data. Thus, the program may be available for viewing at an appropriate time

and/or a convenient time to the viewer, and bandwidth may be saved for transmission of additional programs.

The remaining obviousness rejections are based on references even further removed from the subject at hand. Gudesen is directed to a system for local processing and accessing large volume of data and is cited to show transmitting data at a rate lower than a retrieval rate of the data and assessing a fee based on a record of selection of the data. Tsuria et al. is directed to a subscriber unit for purchasing programs and is cited to show maintaining a record of selection in an access card. Even assuming, *arguendo*, that Gudesen and Tsuria et al. disclose such features, it is respectfully submitted that they fail to disclose or suggest the use of a boot object having location information associated with cache program data and requiring storage of the cache program data. Both Gudesen and Tsuria et al. fail to disclose or suggest identifying where data for a cache program is found for a receiver station and requiring the receiver station to store the cache program data. Accordingly, the obviousness rejections based thereon should be withdrawn.

It is well established that the prior art must teach or suggest each of the claim elements and must additionally provide a suggestion of, or an incentive for, the claimed combination of elements to establish a *prima facie* case of obviousness. *See In re Oetiker*, 24 U.S.P.Q. 2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985); *In re Royka*, 490 F.2d 981 (CCPA 1974) and M.P.E.P. § 2143. Because none of the cited references discloses or suggests the use of a boot object having location information associated with cache program data and requiring storage of the cache program data, it follows that no combination of these references renders the pending claims obvious.

The general principle that the prior art must teach of suggest each claim element and provide a suggestion or modification for the claimed combination holds true even if the applied art could be modified to produce the claimed invention. *See In re Mills*, 16 U.S.P.Q.

1430, 1432 (Fed. Cir. 1990); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."). Because neither of the applied references discloses or suggests the desirability of using a boot object having location information associated with cache program data and requiring storage of the cache program data, as recited by the claims at issue, there is no motivation for the modification that the examiner suggests.

In order for the references to provide such a suggestion, the problem of limited bandwidth must first be recognized. For example, a broadcaster may designate a program to cache, and transmit cache program data at a rate slower than real time over a lengthy period of time prior to being available for viewing and without the viewer's prior request. As a result, the broadcaster maximizes its available bandwidth because the amount of bandwidth saved from the cache program may be used for additional transmissions to generate more revenue. However, the cited references are silent in this regard. As evidence attesting to the scope of the problem solved by the inventors, the applicants note the advantages of allowing the broadcaster to record a program into a cache without the viewer's prior request by using a boot object to inform a receiving station of where the cache program data is located. Such a problem has remained unsolved and clearly not obviated by the cited references. The applicants therefore respectfully submit that the obviousness rejections in light of the cited references should be withdrawn.

For these reasons, it is respectfully submitted that the claims are in condition for allowance. If, for any reason, the examiner is unable to allow the application in the next Official action, the examiner is encouraged to telephone the undersigned attorney at the telephone number listed below to discuss this matter.

Respectfully submitted,

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